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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,964	11/27/2000	Kaoru Uchida	14098	5139

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EXAMINER

CARTER, AARON W

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 11/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/722,964

Applicant(s)

UCHIDA, KAORU

Examiner

Aaron W Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-11, 15 and 16 is/are rejected.
- 7) ☒ Claim(s) 4-6 and 12-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4,5. 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 7, 9 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,518,252 to Price-Francis.
4. As to claims 1 and 9, Price-Francis discloses a user authentication apparatus, comprising:
Authentication means for authenticating a user by verification of biometrics of the user, which is a biological characteristic unique to an individual (Fig. 2);
Acquisition means operable when the authentication by said authentication means results in failure in the verification of the biometrics for acquiring biometrics data of the user who has requested for the authentication; and
Substitute authentication means for substituting the verification of biometrics when the biometrics data is acquired by said acquisition means (Fig. 2, wherein the acquisition of

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fingerprint, at element 66, is compared with stored data, at element 82, and if verification fails, element 110, then the process starts over with acquiring more biometrics and evaluating the substitute biometrics, element 64).

As to claims 7 and 15, Price-Francis discloses a user authentication apparatus as claimed in claim 1, wherein at least a fingerprint is used as the biometrics (Fig. 2).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price-Francis as applied to claims 1 and 9 above, and further in view of US Patent 6,141,436 to Srey et al. ("Srey").

As to claims 2 and 10, Price-Francis discloses a user authentication apparatus as claimed in claim 1, as well as a storage means for storing the biometrics data acquired by said acquisition means (Fig. 2, elements 66, 69, 75 78 and 82, wherein it is inherent that the biometrics data is stored after being acquired at (66) since the fingerprints characteristics are extracted and evaluated against authorized fingerprint data), but Price-Francis is silent about limitations of a processing means for performing search and pursuit of an illegal user based on the biometrics

data stored in said storage means. However, Srey discloses storing biometrics data after a failure in verification occurs (column 9, lines 10-30), and a processing means for performing search and pursuit of an illegal user based on that biometric data (column 9, lines 30-37). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to take the biometric identification that provides a reduction of false negatives as disclosed by Price-Francis and combined it with the biometric authorization/identification technique taught by Srey, providing increased security, and fraud prevention and detection (column 9, lines 21-22).

7. Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price-Francis as applied to claims 1 and 9 above, and further in view of US Patent 5,799,098 to Ort et al. ("Ort").

As to claims 3 and 11, Price-Francis discloses the a user authentication apparatus as claimed in claim 1, and also discloses that false negatives may be the result of poor quality fingerprint images, therefore immediate rejection of the individual may be premature (column 6, lines 59-67). Price-Francis neglects to explicitly disclose the limitation of determining quality of biometric data and if the quality is not suitable for automatic comparison, then the data is to be stored. However, Ort teaches us a process of fingerprint identification and authorization in which a fingerprint image acquired, divided into a plurality of blocks each containing biometric data and the quality of each block is determined. Although the quality is determined to be of low quality or unsuitable for automatic comparison, the biometric data is still recorded (Abstract, lines 5-7). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to take the biometric identification that provides a reduction of false negatives as

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disclosed by Price-Francis and combined it with the biometric authorization/identification technique taught by Srey, this providing rapid comparison of a fingerprint with those fingerprints of individuals in the repository database (column 6, lines 1-3).

8. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price-Francis as applied to claims 1 and 9 above, and further in view of US Patent 6,430,306 to Slocum et al. ("Slocum").

As to claims 8 and 16, Price-Francis discloses a user authentication apparatus as claimed in claim 1, but neglect to explicitly disclose that upon storage of biometrics data prior to the substitute authentication, at least an image of the face and/or a figure, when a fingerprint is inputted, are photographed. However, Slocum teaches us a process of biometric identification where, as part of an effort to deter individuals from gaining false entry, a photograph of the individuals face is taken and stored for use by law enforcement (column 9, lines 37-45 and column 10, lines 22-32). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to take the biometric identification that provides a reduction of false negatives as disclosed by Price-Francis and combined it with the biometric identification technique taught by Slocum, this providing improved systems and methods for maintaining databases that store image information as part of a data record.

Allowable Subject Matter

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9. Claims 4-6 and 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 5,963,656 to Bolle et al. discloses a method of determining quality of a fingerprint image.

US Patent 6,078,265 to Bonder et al. discloses a method of storing the fingerprint of an unauthorized user.

US Patent 6,259,805 to Freedman et al. discloses a method of recapturing biometric data if original is unsatisfactory.

US Patent 6,160,903 to Hamid et al. discloses a method of recapturing biometric data if original is unsatisfactory.

US Patent 5,933,515 to Pu et al. discloses a method of recapturing biometric data if original is unsatisfactory.

US Patent 5,999,637 to Toyoda et al. discloses a method of recapturing biometric data if original is unsatisfactory.

US Patent 6,072,891 to Hamid et al. discloses a method of recapturing biometric data if original is unsatisfactory.

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US Patent 6,195,447 to Ross discloses a method of recapturing biometric data if original is unsatisfactory.

Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron W. Carter whose telephone number is 703.306.4060. The examiner can normally be reached by telephone between 8am - 4:30pm (Mon. – Fri.).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on 703.308.5246. The fax phone number for the organization where the application or proceeding is assigned is 703.872.9306 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.0377.

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November 19, 2003

Aaron W. Carter
Examiner
Art Unit 2625


Jayanti K. Patel
Primary Examiner